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10/050,998	01/22/2002	Jeong-Min Yoon	MM4489	7776

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EXAMINER	
WEINSTEIN, STEVEN L	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/050,998

Applicant(s)

YOON ET AL.

Examiner

Steven L. Weinstein

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09/02/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Applicant's response to the restriction requirement has been received. Group I has been elected without traverse. Accordingly, claims 1-4 and 10 are pending for examination and claims 6-10 are withdrawn from further consideration as being drawn to a non-elected invention. Upon reconsideration, the election of species is hereby withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-4 and 10 are rejected under 35 USC 112 second paragraph for being indefinite. Claim 1 is replete with errors in antecedent basis and inconsistent references which makes the claim confusing. For example, in line 3, should "the" first mixture read - a first mixture? In line 4 should "a" temperature read - the temperature of the first mixture?; in lines 6 and 7, should the line read - partially cooling the first mixture until its surface temperature is about 30 to 45°C-? in line 9 should the phrase read - ...onto the first mixture wherein the printing process is carried out at a temperature? In line 11, which "mixture" is dried?; in line 12, should the second mixture read - a second mixture?; in lines 13 and 14, the phrase should probably read - atop the printed first mixture while the temperature - ; in line 13 after "and" - then - should probably be added; and in line 14, it is not clear what mixture is the "resulting" mixture. The first and second mixtures do not apparently mix. Is this a reference to the second mixture? Support in the specification should be shown for any changes made.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 10 are rejected under 35 USC 112, first paragraph for being non-enabling. It is not clear what is being dried in the phrase "drying the mixture." It is also not clear what is being cooled in the phrase "cooling the resulting mixture." Also, there appears to be no support in the specification for the recitation in new claim 10, "and the mixtures <sup>thereof</sup> ~~of there~~" which reads on just red and yellow or blue and yellow or red and blue.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn (EP 734,655), Nagasawa (JP 62-36151) and Ahn (5,834,047), further in view of Human KK (JP. 8-176), Hens (Ep 462093) and Martorana (WO-78157)

In regard to claim 1, Ahn (Ep'655) discloses pouring a measured amount of a first candy mixture into a mold, allowing the first mixture to cool, printing a desired picture on the first mixture using edible dyes, pouring a measured amount of a second candy mixture onto the mold a top the first candy mixture and cooling the second candy mixture. Nagasawa and Ahn ('047) are relied on as further evidence of these steps. Claim 1 recites particular ranges of temperatures and humidity. Once it is known to perform the steps of molding, printing, then further molding, the particular variable ranges selected are seen to have been an obvious matter of routine determination. For example, the candy mixtures must be heated to ranges such as recited in order to melt

and mix the ingredients, to allow the mixture to be poured, and to allow the mixture to solidify upon cooling to below its solidification temperature. In regard to the temperature range for cooling, 30°C is 86°F, which is sufficiently cool to allow most candy to either solidify or at best be tacky. In regard to the temperature and humidity associated with printing, these temperatures and humidity, presumably of the air in the room in which the printing is to take place, are typical normal room temperature readings (45°C e.g. being 77°F). Claim 1 also recites that pad printing is employed. Pad printing is a well established means of printing on foods as shown, for example, by Ahn ('655) and further evidenced by Human KK, Hens, and Martorana. In regard to claim 4, Ahn ('655) and Najasawa disclose it was conventional to insert a stick into the first mixture.

Claims 2, 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Nippon Elanco KK (Jp 1-178564).

Claim 10 recites that the ink comprises ethanol, shellac, carnauba wax and one or more colorant lakes. Ahn ('655), Nagasawa and Ahn ('047) are not specific as to the ink composition. As evidenced by Nippon Elanco, the recited ingredients are well-known, conventional ingredients of edible inks. To modify or substitute in Ahn ('655), as further evidenced by Nagasawa and Ahn, ('047), one conventional edible ink composition for another conventional edible ink composition for its art recognized and applicants intended function would have been obvious. The particular composition of inks (claim 2) if not already taught by Nippon Elanco would have been an obvious

routine determination. It is noted that claim 3 is at least somewhat redundant since it claims additives already claimed in claim 2.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/049748 in view of An ('655), Nagasawa (Jp 62-36151) and Ahn (5,834,047) further in view of Human KK (Jp 8-176), Hens (Ep 462093) and Martorana (WO/78157), who teach that it would have been obvious to employ heating, cooling, pad printing, and single or double molds. That is, the claims of the present application are obvious variants of those of 10/049748.

This is a provisional obviousness-type double patenting rejection.

The remainder of the references cited on the USPTO 892 forms are cited as pertinent art.

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Any inquiry concerning this communication from the examiner should be directed to Steven Weinstein whose telephone number is 703-308-0650. The examiner can normally be reached on Monday-Friday 7:00am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone number for the organization where this application is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0661.

S. Weinstein/lap  
November 3, 2003



STEVE WEINSTEIN  
PRIMARY EXAMINER 1761  
11/12/03